

REMARKS

The title has been amended to remove the word “new”.

Claims 1 to 7 were pending. Claims 2 to 7 have been canceled, claim 1 has been amended, and claims 8 to 10 have been added. Support for claim 8 can be found at page 3, line 9, and page 6, lines 10 to 13. Support for claims 9 and 10 can be found at page 9, lines 1 to 6, and page 15. Claims 1 and 8 to 10 will be pending and under examination after entry of this amendment.

Claim 1 has been amended to conform in most respects to claim 1 of U.S. Patent No. 6,638,925 B2, the parent of the pending application.

The Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

Applicants respectfully traverse this rejection of the claims. Although Applicants disagree with the Examiner, claim 1 has been amended to expedite prosecution of this application.

(i) The Examiner rejected claim 1 because the term “substituted” appears numerous times without specifying the substituents. Applicants have amended the claims so that “substituted” only occurs in conjunction with a list of substituents.

(ii) (a) The Examiner rejected claim 1 for the recitation of both “substituted lower alkyl” and some other substituents in the definition of R_1 and R_2 . Applicants have deleted the term “substituted lower alkyl” from the definition of R_1 and R_2 .

(ii) (b) The Examiner rejected claim 1 for the recitation of both “alkoxy carbonyl” and “COO alkyl” in the definition of R_1 and R_2 . The definition of R_1 does not recite “alkoxy carbonyl” as a possibility for R_1 itself. This language at page 86, line 10, of claim 1 as originally filed modifies “an amino group

substituted by....” Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of claim 1.

(ii) (c) The Examiner rejected claim 1 for the recitation of both “alkoxy” and “OCH₃” in the definition of R₁ and R₂. Applicants have deleted “OCH₃” from the definition of R₁ and R₂.

(iii) The Examiner rejected claim 1 for the recitation of “in which” in the definition of R₁ and R₂. Applicants have deleted “in which” from the definition of R₁ and R₂.

(iv) The Examiner rejected claim 1 for the recitation of “N = 1 to 3” in the definition of R₂ and R₃. Applicants have replaced this recitation with “n = 1 to 3”. The Examiner also asks whether this “n” is applicable to each occurrence. This definition of “n” is applicable to each occurrence.

(v) The Examiner rejected claim 1 because R₇ is not defined. Applicants have deleted all reference to R₇ in claim 1.

(vi) The Examiner rejected claim 1 because the definition of R₄ and R₅ is confusing and suggested that language indicating these groups are independent be added. Appropriate language has been added.

(vii) The Examiner rejected claim 1 because it is unclear what the “O-protective group” is and what the O is supposed to be protected against. A similar rejection was overcome in the parent application. One of skill in the art understands that the “O-protective group” is a group that protects the oxygen atom from further reaction of any sort.

(viii) The Examiner rejected claim 1 for reciting “thiourethanes” in parentheses. This recitation has been deleted from claim 1.

(ix) The Examiner rejected claim 1 for reciting “including” in the definition of R₄ and R₅ and because the definition of R₈ does not permit the three groups depicted. The recitation of “including esters with a substitution pattern of amino

acids as follows” has been deleted. “O-CO-R₈” has been separated from the three immediately following structures to eliminate any confusion in the definition of R₄ and R₅.

(x) The Examiner rejected claim 1 for reciting “hydrazone” and “oximes” and for reciting “-N = N(R₁₀, R₁₁)”. The terms “hydrazone” and “oximes” have been deleted and “-N = N(R₁₀, R₁₁)” has been replaced by “-N = N(R₁₀R₁₁)”.

(xi) The Examiner rejected claim 1 for reciting “as well as” on page 87. The term “as well as” has been deleted.

(xii) The Examiner rejected claim 1 for reciting “sulfonic acid group” and suggested that this term be replaced with “-SO₃H”. Claim 1 has been amended as suggested.

(xiii) The Examiner rejected claim 1 for the form of the definition of Y₁ and Y₂. The definition of Y₁ and Y₂ has been amended to conform to the Examiner’s suggestion.

(xiv) The Examiner rejected claim 1 for reciting “-C(R₁₅, R₁₆)-”. The term “-C(R₁₅, R₁₆)-” has been replaced with “-C(R₁₅R₁₆)-” as suggested by the Examiner.

(xv) The Examiner rejected claim 1 for reciting “that is an ortho, meta or para disubstituted aromatic”. The phrase has been deleted from claim 1.

(xvi) The Examiner rejected claim 1 for reciting “P = 1”. The term “P = 1” has been replaced with “p = 1”.

(xvii) The Examiner rejected claim 1 for reciting “compounds of the general formula (II)”. This phrase has been replaced with “A compound of formula (II)” as suggested by the Examiner.

(xviii) The Examiner rejected claim 1 for reciting “CONH” and “CON alkyl” in the definition of R₁ and R₂ because these groups have open valencies.

These substituents have been changed to "CONH₂" and "CON(alkyl)₂" as suggested by the Examiner.

(xix) The Examiner rejected claim 1 for reciting "R_a" in the definition of R₄ and R₅. The claim recites "R₈" not "R_a". See the published version of this application, US 2004/0067974 A1. The Examiner also stated that it is unclear how G₁ and G₂ can jointly be an alkyl spiro group. The definition of G₁ and G₂ has been changed and rearranged in the claim. The definition of G₁ and G₂ now recites that "G₁ and G₂ may jointly represent a C₃ to C₇ alkyl spiro ring group" and this recitation now follows immediately after a recitation that "G₁ and G₂ may jointly represent" a cycloalkyl structure. With this redrafting of the claim, it is now clear how G₁ and G₂ jointly represent an alkyl spiro group.

(xx) The Examiner rejected claim 1 for reciting "heteroaryl" in the definition of R₂₁. Claim 1 has been amended to recite "heteroaryl group selected from the group consisting of 2-pyridyl, 4-pyridyl, and 2-pyrimidinyl". Support for this amendment can be found at page 5, lines 12 and 13, of the specification.

(xxi) The Examiner rejected claim 1 because the variable R₇ is not defined. All references to R₇ have been deleted from the claim.

(xxii) The Examiner rejected claim 1 because the Examiner contends that it is unclear how G₁ and G₂ can jointly be an alkyl spiro group. This point has been addressed in (xix) above.

(xxiii) The Examiner rejected claim 1 because the variable "Z" is defined as N or N⁺. The variable "Z" has been defined as N⁺ as suggested by the Examiner.

Claim 1 has been amended to recite "G₆" in place of "G₈" at page 90, line 1, of claim 1 as originally filed. Support for this amendment can be found in the specification at page 5, line 17.

"NH₂" has been added to the list of substituents at page 89, second line from the bottom of the page, of claim 1 as originally filed. Support for this

amendment can be found in the specification at page 5, line 16. A structure at page 90, line 3, of claim 1 as originally filed has been corrected. Support for this amendment can be found in the specification at page 5, line 19.

In view of the above amendments and remarks, Applicants respectfully request that the Examiner withdraw the rejection of claim 1.

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Respectfully submitted,

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